

REMARKS

By this amendment, Applicant cancels claims 2, 3, 5, 6, and 12 without prejudice or disclaimer of the subject matter thereof, amends claims 1, 4, 7, 8, 11, 13, and 14, and adds new claims 17 and 18. Claims 1, 4, 7-11, and 13-18 are currently pending.

In the Office Action, the Examiner allowed claims 9, 10, 15, and 16. The Examiner withdrew the indicated allowability of claims 2-8, 13, and 14 in view of newly discovered reference, U.S. Patent No. 6,400,961 to Lillie et al. (hereinafter "Lillie"), and rejected claims 1-8 and 11-14 under 35 U.S.C. § 102(e) as anticipated by Lillie.

Applicant appreciates the Examiner's thorough examination of this application, especially the detailed citations which aided Applicant in reviewing the Examiner's comments. Applicant thanks the Examiner for allowing claims 9, 10, 15, and 16. Nevertheless, Applicant respectfully traverses the rejections for the following reasons.

Regarding Claim Rejections under 35 U.S.C. § 102(e)

In order to anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1 and 7, as amended, include "means for periodically executing an inquiry scan." Lillie fails to teach "means for periodically executing an inquiry scan," as required by amended claims 1 and 7.

Lillie discloses a communication apparatus to vary "the frequency of searching (scanning) for available communication networks" as "a function of information about

the local availability of the communication networks,” and “this information also to be reported . . . via appropriate keys and/or by menu controlled by the user.” Lillie, col. 1, line 66 to col. 2, line 4. However, the “searching (scanning) for available communication networks” does not constitute an “inquiry scan” as disclosed in the present invention. For example, as described on page 9 of the Specification: “[a] given terminal that permits another terminal to search out (find) the given terminal itself performs Inquiry Scan (terminal search wait processing) to respond to an Inquiry message.” (emphasis added). This is quite different from a terminal scanning for any available network. Thus, Lillie fails to teach at least “means for periodically executing an inquiry scan,” as required by amended claims 1 and 7.

Furthermore, amended claim 1 calls for a combination also including, for example, “means for monitoring a traffic of the communication channel.” As stated above, Lillie only teaches controlling the frequency based on the “local availability.” However, the “local availability” is not equivalent to the “traffic of the communication channel.” Thus, Lillie also fails to teach at least “means for monitoring a traffic of the communication channel,” as required by amended claim 1.

Claim 7, as amended, includes “user interface means for setting preferentiality related to one of the data transmission/reception and the inquiry scan in accordance with a user operation.” As explained above, Lillie merely teaches reporting local availability of the communication networks “via appropriate keys and/or by menu controlled by the user.” Such teaching does not constitute “setting preferentiality related to one of the data transmission/reception and the inquiry scan in accordance with a user operation” (emphasis added) as required by amended claim 7.

In light of above remarks, Applicant respectfully submits that Lillie fails to disclose each and every element of amended claims 1 and 7, either expressly or inherently.¹ Applicant requests the withdrawal of the rejection of claims 1 and 7. Since claim 4 depends on claim 1 and claim 8 depends on claim 7, the rejection of claims 4 and 8 should also be withdrawn for at least the same reasons stated above. Since claims 11 and 13 are method claims reciting similar claim elements of claims 1 and 7, respectively, for at least the same reasons stated above, Applicant also requests the withdrawal of the rejection of claims 11 and 13, and the dependent claim 14.

Regarding New Claims 17 and 18

Applicant respectfully submits that claims 17 and 18 are fully supported by the disclosure of the present invention. The support may be from, for example, descriptions on page 32 of the Specification. Since claims 17 and 18 depend on claims 10 and 16, respectively, and claims 10 and 16 have been allowed, Applicant further submits that claims 17 and 18 should be allowed as well.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

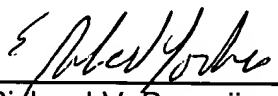
¹ Applicant further disagrees with the Examiner's statement that Lillie "discloses the apparatus/method in which a communication channel and a control channel are exclusively assigned to a radio communication resource to be used." (Office Action, pp. 1-2). Lillie does not disclose any information on whether a communication channel and a control channel are "exclusively assigned." In fact, the Lillie invention is used in GSM-type communication networks, where communication channels and control channels are assigned separately but used simultaneously.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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